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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ERIC PAUL GIBBS and MARK EDWARD PHILLIPS

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Appeal 2008-5906  
Application 09/975,749  
Technology Center 2600

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Decided:<sup>1</sup> March 18, 2009

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT, and MARC S. HOFF, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 28-37, which are all of the pending claims. Claims 1-27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed May 17, 2007), Answer (mailed September 19, 2007), and Reply Brief (filed November 23, 2007) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

#### APPELLANTS' INVENTION

Appellants' claimed invention relates to a battery-powered portable media player which utilizes a spinning media device for data storage. Battery power is conserved by not powering the media storage device until actual data transfer is required. The amount of data remaining in a random-access-memory (RAM) component is calculated and, based on a number of factors, a determination is made as to when it is necessary to power up the media storage device to ensure that a continuous stream of data is provided to the RAM component. The RAM component stores compressed data in more than two different buffer areas, each of which is lockable and unlockable by a processor. A coder/decoder (CODEC) reads compressed data from the locked buffer and compressed data is written to the unlocked buffers. (Spec. 6:3-20 and 17:27 to 18:8).

Claim 28 is illustrative of the invention and reads as follows:

28. A portable media player comprising:

- a processor that executes commands;
- a random-access-memory component that stores compressed data in more than two different random-access-memory buffer areas, each random-access-memory buffer lockable and unlockable by the processor;
- a codec component, controlled by the processor, that reads compressed data from a locked random-access-memory buffer, the locked random-access-memory buffer selected from among the more than two different random-access-memory buffer areas and locked by the processor to prevent writing of the locked random-access-memory buffer by another component, and that generates a decompressed signal from the read compressed data that is rendered by a data-rendering component;
- a non-volatile, mass-storage component that stores compressed data and that writes compressed data, under control of the processor, to unlocked random-access-memory buffers; and
- a battery power supply to provide electrical power to the processor, random-access memory component, codec component, data-rendering component, and non-volatile, mass-storage component.

#### THE EXAMINER'S REJECTION

The Examiner relies on the following prior art references to show unpatentability:

Biliris	US 5,720,037	Feb. 17, 1998
Birrell	US 6,332,175 B1	Dec. 18, 2001 (filed Feb. 12, 1999)

Claims 28-37, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Birrell in view of Biliris.

## ISSUES

*Under 35 U.S.C. § 103(a), with respect to appealed claims 28-37, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Birrell and Biliris to render the claimed invention unpatentable?*

The pivotal issues before us are whether Appellants have demonstrated that the Examiner erred in finding:

- (a) in order to prevent previously played data in a retained data portion of a RAM buffer in Birrell from being overwritten with data, the retained data portion of the RAM buffer would inherently be locked to prevent access.
- (b) the obviousness to the ordinarily skilled artisan of modifying the single buffer disclosure of Birrell by applying the circular plural buffer arrangement teachings of Biliris.

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Birrell discloses (Fig. 1, col. 6, ll. 5-28) a portable media player having play control logic which monitors the amount of data remaining in a RAM buffer 108 and initiates the transfer of new data to the buffer from disk 104 when the amount of remaining data is below a predetermined threshold.

2. Birrell also discloses (col. 6, ll. 29-42) that, in order to save power, the disk 104 is powered on only long enough to copy new data into Ram 108.

3. Birrell also discloses (col. 6, l. 64-col. 7, l. 2) an embodiment in which RAM buffer 108 is not completely overwritten with data once a threshold is reached but, rather, a final portion of previously played data is retained to accommodate a user's reversal of play or rewind.

4. Biliris discloses (Fig. 5A, col. 5, l. 48 to col. 6, l. 1) a multimedia server utilizing RAM buffers implemented as a circular buffer permitting improved fast-forward and rewind operations.

#### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

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*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 28, the sole independent claim on appeal, based on the combination of and Birrell and Biliris, Appellants assert that the Examiner has failed to set forth a *prima facie* case of obviousness since all of the claim limitations are not taught or suggested by the applied prior art references. Appellants' arguments (App. Br. 6-8; Reply Br. 5-10) focus on the contention that, in contrast to the claimed invention, the primarily relied upon Birrell reference does not disclose, *inter alia*, the reading of compressed data from a *locked* RAM buffer by a codec component, nor the prevention of writing to the *locked* RAM buffer by another component. We are in general agreement with Appellants' position as stated in the Briefs.

The Examiner, in addressing the requirements of independent claim 28, directs attention (Ans. 4, 8, and 9) to the embodiment discussed at column 6, line 64 to column 7, line 2 of the portable audio player disclosure of Birrell. In this cited portion, Birrell discloses that, while RAM buffer 108 is overwritten with new data from disk 104 once the amount of unplayed data from buffer 108 reaches a threshold, the buffer is not completely overwritten. Rather, as described by Birrell, the final portion of previously played data is retained to accommodate the situation in which a user reverses the direction of play, i.e., rewinds to replay previously played data.

The Examiner's stated position recognizes that Birrell does not explicitly disclose that the portion of the RAM buffer 108 which includes the retained previously played data is locked, i.e., access to the buffer by certain components is prevented. The Examiner, nevertheless, concludes that it is inherent in Birrell that such retained data buffer portion would be locked to prevent the retained data from being overwritten with new data.

As asserted by Appellants (App. Br. 7-8; Reply Br. 7-10), however, while ensuring that the retained data portion of the buffer 108 in Birrell is not overwritten is a worthwhile goal, it does not *necessarily* follow that such retained data buffer portion would be locked to achieve such a goal. For example, as also suggested by Appellants (App. Br. 7-8; Reply Br. 7), the play logic in Birrell could issue instructions to the disk 104 to fill the buffer 108 only up to the retained data portion, thereby not overwriting the retained data portion, but without putting the retained data buffer portion in a locked state. We agree with Appellants that there is no basis in the disclosure of Birrell or elsewhere to support the Examiner's finding that, because a process needs not to overwrite a buffer memory portion, the locking of the buffer memory portion would be inherent.

We recognize that the Examiner, in the responsive to arguments portion of the Answer at page 10, has set forth an interpretation of the claimed term *locked* that is presumably based on the description appearing at page 17, line 27 to page 18 line 8 of Appellants' Specification. According to the Examiner, a locked buffer memory can be reasonably interpreted as meaning a memory in which only read operations are allowed.

Appellants have taken issue with the Examiner's position (Reply Br. 6-10) that the cited portion of the Specification provides a definition of a

*locked* memory as one in which only read operations are allowed.

According to Appellants, the allowing of only read operations is only an exemplary result of memory locking and the term *locked* memory should be given its generally accepted meaning of a memory in which access is prevented by certain components.

It is our finding that, even if we accept, *arguendo*, the Examiner's proffered definition of the term *locked* as identifying a memory as one in which only read operations are permitted, there is nothing in the disclosure of Birrell which would support the position that it *necessarily* follows that only read operations are allowed from the retained data portion of buffer 108 of Birrell.

To establish inherency, evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and would be recognized as such by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) *citing Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental*, 948 F.2d at 1269.

We have also reviewed the disclosure of Biliris relied upon by the Examiner as providing a disclosure of improving the fast-forwarding and rewinding of multimedia streams by using a plurality of RAM buffers arranged in a circular fashion. We find nothing, however, in the disclosure of Biliris which overcomes the innate deficiencies of Birrell discussed *supra*.

In view of the above discussion, we are of the opinion that the applied prior art references, even if combined, do not support the obviousness

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rejection. We, therefore, do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 28, nor of claims 29-37 dependent thereon.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have shown the Examiner erred in rejecting claims 28-37 for obviousness under 35 U.S.C. § 103(a).

#### DECISION

The Examiner's 35 U.S.C. § 103(a) rejection of claims 28-37, all of the appealed claims, is reversed.

REVERSED

ELD

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